

**REMARKS**

Applicants reply to the Final Office Action mailed on November 2, 2005, within two months. Thus, Applicants request an Advisory Action, if necessary. Claims 1-19 are pending in the application and the Examiner rejects Claims 1-19. Applicants amend Claim 1. No new matter is added in this Reply and the amendments are supported by the originally-filed specification, drawings and claims. Reconsideration of this application is respectfully requested.

The Examiner advised Applicants that under 37 C.F.R. § 1.56, Applicants are obligated to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made. Applicants respectfully assert that the subject matter of the various claims was commonly owned at the time the inventions covered therein were made and therefore, Applicants have complied with 37 C.F.R. § 1.56.

**35 U.S.C. § 103 REJECTIONS**

The Examiner rejects Claims 1-19 under 35 U.S.C. § 103(a) as being unpatentable over Black, U.S. Patent No. 6,925,565 ("Black"). The Examiner claims that "Re Claim 1, Black teaches a transponder reader system configured with a biometric security device (fingerprint sensor FIG. 1A), the system comprising a transponder (FIG. 1A) configured to communicate with a reader (transponder FIG. 1A), where the reader and biometric security device communicate with a host (host computer FIG. 1A+), the biometric security device comprising a biometric sensor (fingerprint sensor FIG. 1A) configured to detect a proffered biometric sample, the biometric sensor configured to communicate with the system." (Pages 2-3). Applicants respectfully traverse.

In general, Black discloses an identity authentication system comprising a device for capturing a customer signature. Black requires a user to provide an electronic signature using a stylus or other similar device ([0016], [0022]). Further, while Black discloses submitting personal data during the registration procedure (Fig. 5A), Black only discloses such personal data to be customer record numbers, customer bank account numbers, account balances and reference prints ([0050]). Black is silent as to providing payment information because Black merely provides access to a payment account. Moreover, Black does not enable both biometric registration and payment. Rather, Black merely provides access to a payment account "when the sensed digital signature matches a reference digital signature" ([0044]).

Further still, Black is limited to associating a single transaction account with the customer record ([0048]-[0049]). That is, Black is limited to sales in which "payment is made instantly from the customer's registered account" ([0048]), and not a transponder with multiple credit and/or debit accounts. Thus, Black does not teach or disclose at least "a verification device configured to verify said proffered biometric sample to facilitate a payment transaction, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account," as recited in independent Claim 1.

Further still, the Examiner admits that Black is "silent to a verification device to verify the sample (authenticity)." (Page 3). While the Examiner "notes that it is well known and conventional in the art to verify that biometric samples are real (living finger, actual eye, etc.) by using procedures such as measuring temperature, blood flow, etc." (Page 3). The Examiner has not provided any examples of such verification devices nor has the Examiner explained why it would have been obvious to combine such devices with Black.

Claims 2-19 variously depend from independent Claim 1 can contain all the elements thereof. Therefore, Applicants assert that Claims 2-19 are differentiated from the cited reference at least for the same reasons as set forth above, in addition to their own respective features.

The Examiner alternatively rejects Claim 13 under 35 U.S.C. § 103(a) as being unpatentable over Black in view of Martizen et al ("Martizen"), as cited in the previous action. The Examiner states that "Re Claim 13, Martizen et al. teaches different registered biometric samples are associated with a different one of personal information, credit card information, debit card information, savings account information, and loyalty point information (FIG. 6A)." (Page 8). Applicants respectfully traverse this rejection.

Martizen generally discloses a system and method for entering information through biometric identifiers, wherein each biometric identifier is associated with a different account. (FIG 6A). However, Martizen associates a single account with each fingerprint, not multiple accounts, as is claimed.

As such, neither Black, Martizen, nor any combination thereof, discloses or suggests at least "a verification device configured to verify said proffered biometric sample to facilitate a payment transaction, wherein said proffered biometric sample is associated with at least two

accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account," as recited in independent Claim 1.

Moreover, Claim 13 indirectly depends from independent Claim 1 and contains all the elements thereof. Therefore, Applicants assert that Claim 13 is differentiated from the cited references at least for the same reasons as set forth above, in addition to its own respective features.

The Examiner rejects Claim 14 under 35 U.S.C. §103(a) as being unpatentable over Black/Martizen et al., as discussed above, in view of Moebs et al. ("Moebs"), as cited in the previous Office Action. The Examiner claims that "Martizen et al. teaches a biometric samples is associated with at least one of a first user account, wherein the first account comprises personal information, credit card information, debit card information, savings account information, and loyalty point information, and wherein the information, where the first account is different than the second account (FIG. 6A), but is silent to primary and secondary associating. Moebs et al. teaches that a customer can avoid overdraft by preauthorizing the financial institution to tie the customer's checking account to one or more of the customers other accounts (paragraph [0017])." (Page 9). The Examiner additionally notes that "such protection is well known in the art, and it would be obvious that by linking the overdraft account to the primary account, that a primary and secondary association is established." (Page 9). Applicants respectfully traverse.

Applicants assert that Moebs is limited to methods for identifying the risk associated with a new or ongoing relationship. That is, Moebs involves performing credit checks for overdraft protection purposes. (Paragraphs 30-32). While Moebs mentions tying "the customer's checking account to one or more of the customer's other accounts such as the customer's deposit accounts" (paragraph 17), there is no motivation to combine Moebs with Martizen or Black, because Moebs does not disclose or suggest using transponders or biometric security. Further, Moebs does not disclose or suggest fingerprint samples or associating fingerprint samples with two different accounts. As such, neither Moebs, Martizen, Black, nor any combination thereof, discloses or suggests at least "a verification device configured to verify said proffered biometric sample to facilitate a payment transaction, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a

charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account,” as recited in independent Claim 1. Moreover, Claim 14 indirectly depends from independent Claim 1 and contains all the elements thereof. Therefore, Applicants assert that Claim 14 is differentiated from the cited references at least for the same reasons as set forth above, in addition to its own respective features.

The Examiner additionally rejects Claim 15 under 35 U.S.C. § 103(a) as being unpatentable over Black, as discussed above, in view of Teicher (“Teicher”), as cited in the previous Office Action. The Examiner notes that “Black is silent to mutual authentication upon verification of the proffered biometric sample.” (Page 10). However, the Examiner states that “mutual authentication is well known and conventional in the art, for security purposes, to ensure that a valid reader and device are communicating. It would have been obvious to one of ordinary skill in the art to mutually authenticate upon verification of the biometric sample, in order to ensure that the transponder and reader are authentic and should be communicating with each other. Specifically, Teicher teaches a contactless smart card that begins mutual authentication after an input (PIN) is entered (col. 7, lines 35+).” (Page 10). Applicants respectfully traverse.

Neither Teicher, Black, nor any combination thereof, discloses or suggests at least “a verification device configured to verify said proffered biometric sample to facilitate a payment transaction, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account,” as recited in independent Claim 1. Moreover, Claim 15 directly depends from independent Claim 1 and contains all the elements thereof. Therefore, Applicants assert that Claim 15 is differentiated from the cited references at least for the same reasons as set forth above, in addition to its own respective features.

The Examiner rejects Claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Black, as discussed above, in view of Goodman et al (“Goodman”) as cited in the previous Office Action. The Examiner states that “Black is silent to deactivating the transponder upon rejection of the biometric sample that is proffered.” (Page 11). However, the Examiner claims that “Goodman et al. teaches deactivation of a card if a predetermined amount of incorrect PIN attempts are detected (paragraph [0029]).” (Page 11). Applicants respectfully traverse.



Neither Goodman, Black, nor any combination thereof, discloses or suggests at least "a verification device configured to verify said proffered biometric sample to facilitate a payment transaction, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account," as recited in independent Claim 1. Moreover, Claim 16 directly depends from independent Claim 1 and contains all the elements thereof. Therefore, Applicants assert that Claim 16 is differentiated from the cited references at least for the same reasons as set forth above, in addition to its own respective features.

The Examiner rejects Claim 19 under 35 U.S.C. § 103(a) as being unpatentable over Black, as discussed above, in view of Haala ("Haala"), as cited in the previous Office Action. The Examiner admits that "Black is silent to a secondary security procedure and sending a signal to the host to notify that a rule for the transponder is being violated." (Page 12). However, the Examiner states that it "is well known and conventional for security...[and that] Haala teaches secondary security procedures (providing user information) (FIG. 3)." (Page 12). Applicants respectfully traverse.

In general, Haala discloses a method and system for preventing a person from negotiating a transaction upon the occurrence of a preselected event, such as verification of the biometric sample. Haala teaches proffering a biometric and a data card to a reader in order to negotiate a transaction (paragraph [0038]), wherein the data card is coded to include biometric and profile information about a person (paragraph [0021]). However, Haala limits the profile information to non-financial or non-payment information such as "name, address, date and place of birth, citizenship, medical and/or personal history, criminal record, passport information (date of issuance, number, issuing country, validity period, etc.), immigration or non-immigration visa information (category and duration, issuing consulate/embassy, etc.), licenses (driver's, pilot, etc.)" (paragraph [0035]). As such, Haala does not disclose the use of its transaction card for any type of payment function. Further still, Haala does not disclose or suggest fingerprint samples or associating fingerprint samples with two different accounts.

As such, neither Haala, Black, nor any combination thereof, discloses or suggests at least "a verification device configured to verify said proffered biometric sample to facilitate a payment transaction, wherein said proffered biometric sample is associated with at least two

accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account," as recited in independent Claim 1. Moreover, Claim 19 directly depends from independent Claim 1 and contains all the elements thereof. Therefore, Applicants assert that Claim 19 is differentiated from the cited references at least for the same reasons as set forth above, in addition to its own respective features.

The Examiner alternatively rejects Claim 19 under 35 U.S.C. §103(a) as being unpatentable over Black, as cited above, in view of Black, U.S. Patent Application No. 2005/0122209 ("Black '209"). The Examiner states that "though Black is silent to sending a signal to the host to notify a rule is being violated, the Examiner notes that it has been discussed above that a transaction only completes when data is verified. Accordingly, it would have been obvious to send records to the host when failed attempts are made, in order to keep detailed records for monitoring activity (possible theft, etc.) of the system....[and that] Black '209 teaches secondary security procedures through comparing the electronic signature (abstract)." (Pages 12-13). Applicants respectfully traverse.

In general, Black '209 discloses an identity authentication system comprising a device for capturing a customer signature. Black '209 is limited to associating a single transaction account with the customer record (FIGS. 10A-B, 11A-B, [0087]). That is, Black '209 is limited to having a card consisting of only one "customer account that is to be used for payment" ([0084]), and not a transponder with multiple credit and/or debit accounts.

As such, neither Black, Black '209, nor any combination thereof, discloses or suggests at least "a verification device configured to verify said proffered biometric sample to facilitate a payment transaction, wherein said proffered biometric sample is associated with at least two accounts, wherein each of said at least two accounts includes at least one of: a charge card account, a credit card account, a debit card account, a savings account, a private label account and a loyalty point account," as recited in independent Claim 1. Moreover, Claim 19 directly depends from independent Claim 1 and contains all the elements thereof. Therefore, Applicants assert that Claim 19 is differentiated from the cited references at least for the same reasons as set forth above, in addition to its own respective features.

***Additional Remarks***

The Examiner suggested that the Applicants review the Hoshino reference to expedite prosecution so that subsequent claim revisions/amendments are not read upon by Hoshino. Applicants thank the Examiner for his remarks. Applicants have reviewed Hoshino and do not believe that it reads upon the present claims.

***Conclusion***

Applicants respectfully submit that the pending claims are in condition for allowance. The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814. Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the application in general.

Respectfully submitted,

Dated: December 1, 2005

By: 

Howard I. Sobelman  
Reg. No. 39,038

**SNELL & WILMER L.L.P.**  
400 East Van Buren  
One Arizona Center  
Phoenix, Arizona 85004-2202  
Telephone: (602) 382-6228  
Facsimile: (602) 382-6070  
E-mail: [hsobelman@swlaw.com](mailto:hsobelman@swlaw.com)